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09/507,967	02/22/2000	Frank David Serena	11423-002001	2781

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

09

Office Action Summary

Application No.

09/507,967

Applicant(s)

SERENA, FRANK DAVID

Examiner

George C Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 35-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 35-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-23 and 35-51 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites the limitation "monitoring content...exchanged between the application program and an operating system residing at the user's computer system". This limitation is not described in the specification to sufficiently enable one skilled in the art to make and/or use the invention.

Claims 18-19 and 21-23 recite similar limitations and therefore also fail to meet the enablement requirement.

Claim 13 recites the limitation "replacing the corresponding predetermined advertisement with a representation of the predetermined advertisement; detecting the representation; and replacing the representation with the other predetermined

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advertisement". This limitation is not described in the specification to sufficiently enable one skilled in the art to make and/or use the invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 13 recites the limitation "the corresponding predetermined advertisement".

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-15, 17-23 and 35-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurtzmann, II [US Patent 6 044 376 A].

Regarding claim 1, Kurtzmann discloses a computer-implemented method of controlling content, the method comprising: receiving input from a user; monitoring content in an application program or content exchanged between the application program and an operating system residing at the user's computer system; determining

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whether monitored content includes a predetermined advertisement; and if the monitored content includes the predetermined advertisement, replacing the predetermined advertisement with another predetermined advertisement based on the user input. [column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 2, Kurtzmann discloses the method of claim 1, wherein receiving input from the user comprises receiving information about content that the user wishes to control. [column 2, lines 9-12; column 3, lines 21-31 and 44-50; column 3, line 58-column 4, line 8]

Regarding claim 3, Kurtzmann discloses the method of claim 2, further comprising generating the other predetermined advertisement based on the received user information. [column 3, line 58-column 4, line 8]

Regarding claim 4, Kurtzmann discloses the method of claim 1, wherein monitoring content comprises monitoring content in a database manager, a spreadsheet, a communications package, a graphics program, a word processor, or a network browser. [column 2, lines 19-29; column 3, lines 33-67]

Regarding claim 5, Kurtzmann discloses the method of claim 1, wherein receiving input from the user comprises receiving information from an organization designated by the user. [column 2, line 66-column 3, line 2; column 3, lines 21-25]

Regarding claim 6, Kurtzmann discloses the method of claim 5, further comprising generating the other predetermined advertisement based on received

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organization information. [column 2, line 66-column 3, line 2; column 3, line 58-column 4, line 18]

Regarding claim 7, Kurtzmann discloses the method of claim 1, wherein monitoring content comprises monitoring text, video, audio, image, animation, or document link in the application program. [column 2, line 52-column 3, line 32; column 4, lines 20-25]

Regarding claim 8, Kurtzmann discloses the method of claim 1, wherein monitoring content comprises monitoring information related to the originator of content. [column 2, line 66-column 3, line 2; column 3, lines 21-25]

Regarding claim 9, Kurtzmann discloses the method of claim 1, wherein monitoring content comprises monitoring content exchanged between a network browser and a network server. [column 3, lines 32-67]

Regarding claim 10, Kurtzmann discloses the method of claim 1, further comprising activating rules including generating rules using the received user input and updating rules using the received user input and the generated rules. [column 2, line 63-column 3, line 32; column 4, lines 1-19]

Regarding claim 11, Kurtzmann discloses the method of claim 10, wherein determining whether monitored content includes a predetermined advertisement comprises: extracting an identifier from the content; and using the rules comparing the extracted identifier with a predetermined set of identifiers that correspond to a predetermined set of advertisements. [column 2, line 52-column 3, line 50; column 4, lines 1-25]

Regarding claim 12, Kurtzmann discloses the method of claim 11, wherein if the extracted identifier matches one of the predetermined sets of identifiers, replacing the corresponding predetermined advertisement with the other predetermined advertisement. [column 2, line 52-column 3, line 67, specifically column 3, lines 58-67; column 4, lines 1-25]

Regarding claim 13, Kurtzmann discloses the method of claim 11, wherein replacing the predetermined advertisement with the other predetermined advertisement comprises: replacing the corresponding predetermined advertisement with a representation of the predetermined advertisement; detecting the representation; and replacing the representation with the other predetermined advertisement. [column 2, line 52-column 3, line 50, specifically column 3, lines 58-67; column 4, lines 1-25]

Regarding claim 14, Kurtzmann discloses the method of claim 1, wherein replacing the predetermined advertisement with another predetermined advertisement comprises replacing the predetermined advertisement with text, video, audio, image, animation, or a link to a document. [column 2, line 52-column 3, line 50, specifically column 3, lines 58-67; column 4, lines 1-25]

Regarding claim 15, Kurtzmann discloses the method of claim 1, wherein replacing the predetermined advertisement with another predetermined advertisement comprises accessing the other predetermined advertisement from a user's computer or from a network server. [column 2, line 52-column 3, line 50, specifically column 2, lines 57-62; column 4, lines 1-25]

Regarding claim 17, Kurtzmann discloses the method of claim 1, wherein monitoring occurs at a network server separate from the user's computer. [column 2, line 52-column 3, line 67]

Regarding claim 18, Kurtzmann discloses software in a computer-readable medium comprising instructions for causing a computer system to perform the following operations: receive input from a user of a computer system; monitor content in an application program or content exchanged between an operating system residing at the user's computer and the application program; determine whether monitored content includes a predetermined advertisement; and if the monitored content includes the predetermined advertisement, replace the predetermined advertisement with another predetermined advertisement based on the user's input. [column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 19, Kurtzmann discloses a computer system for controlling content, the system comprising a client computer programmed to receive input from a user and to operate an application program; and a second computer interconnected with the client computer by an internetwork and programmed to: observe content in the application program or content exchanged between the application program and an operating system residing at the client computer, determine whether observed content includes a predetermined advertisement, and if the observed content includes the predetermined advertisement, replace the predetermined advertisement with a predetermined identifier that corresponds to another predetermined advertisement

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based on the user input. [column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 20, Kurtzmann discloses the computer system of claim 19, further comprising a second set of instructions for programming the second computer to: receive the predetermined identifier; and replace the predetermined identifier with the corresponding other predetermined advertisement. [column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50, specifically column 3, lines 32-67; column 3, line 58-column 4, line 25]

Regarding claim 21, Kurtzmann discloses a computer-implemented method of controlling content in an application program or in a communication channel between an operating system residing at a user's computer system and the application program, the method comprising: receiving an input from the user; observing content exchanged between the application program and the operating system; determining whether observed content includes predetermined advertisement content would direct the user to a predetermined advertisement; and if the observed content includes predetermined advertisement content that would direct the user to the predetermined advertisement, replacing the observed content with other content that directs the user to another predetermined advertisement based on the user input. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 22, Kurtzmann discloses software in a computer-readable medium comprising instructions for causing a computer system to perform the following

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operations: receive input from a user of a computer system; monitor content in an application program or content exchanged between an operating system residing at the user's computer and the application program; determine whether monitored content includes predetermined advertisement content that would direct the user to a predetermined advertisement; and if the monitored content includes predetermined advertisement content that would direct the user to the predetermined advertisement, replace the monitored content with other content based on the user's input. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 23, Kurtzmann discloses a computer system for controlling content, the system comprising: a client computer programmed to receive input from a user and to operate an application program; a second computer interconnected with the client computer by an internetwork and programmed to: observe content in the application program or content exchanged between an operating system residing at the client computer and the application program, determine whether observed content would direct the user to a predetermined advertisement, and if the observed content would direct the user to the predetermined advertisement, replace the observed content with other content based on the user input. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 35, Kurtzmann discloses a method of controlling content in a processing environment in which the content may be accessed, the method comprising:

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receiving input from a user; monitoring content in the processing environment to be accessed by the user; determining whether monitored content includes a predetermined advertisement; if the monitored content includes the predetermined advertisement, selecting a selected advertisement, based on the user input, for incorporation into the content; and causing the content to be accessed by the user with the selected advertisement incorporated therein. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 36, Kurtzmann discloses the method of claim 35 wherein the predetermined advertisement is one of a plurality of advertisements from which the selected advertisement is selected. [column 2, lines 57-62]

Regarding claim 37, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user is content to be viewed by the user. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 38, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises text. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 39, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises video. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 40, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises sounds. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 41, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises images. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 42, Kurtzmann discloses the method of claim 35 wherein the content to be accessed by the user comprises movies. [column 3, lines 33-67, specifically lines 44-50]

Regarding claim 43, Kurtzmann discloses the method of claim 35 wherein the processing environment through which the content is accessed by the user comprises a television tuner for receiving television signals that carry the content. [column 2, lines 19-29; column 5, line 62-column 6, line 2]

Regarding claim 44, Kurtzmann discloses the method of claim 35 wherein the processing environment is a computer application program or a communication channel between an operating system residing at a users computer system and the computer application program. [column 3, lines 33-67]

Regarding claim 45, Kurtzmann discloses the method of claim 35 wherein monitoring content comprises monitoring information related to the originator of content. [column 2, line 66-column 3, line 2; column 3, lines 21-25]

Regarding claim 46, Kurtzmann discloses the method of claim 35, wherein the step of receiving input from a user comprises receiving directly from the user

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information about content that the user wishes to control. [column 2, lines 9-12; column 3, lines 21-31 and 44-50; column 3, line 58-column 4, line 8]

Regarding claim 47, Kurtzmann discloses the method of claim 35, wherein the step of receiving input from a user comprises observing information relating to the user and generating content preferences based on these observations. [column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 48, Kurtzmann discloses software in a readable medium comprising instructions for causing a processor to perform the following operations in a processing environment in which content may be accessed: receive input from a user; monitor content in the processing environment to be accessed by the user; determine whether monitored content includes a predetermined advertisement; if the monitored content includes the predetermined advertisement, select a selected advertisement, based on the user input, for incorporation into the content; and cause the content to be accessed by the user with the selected advertisement incorporated therein. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 49, Kurtzmann discloses a method of controlling content in a processing environment in which the content may be accessed, the method comprising: receiving input from the user; monitor content in the processing environment to be accessed by the user; determining whether monitored content includes predetermined advertisement content that would direct the user to a predetermined advertisement; and if the monitored content includes predetermined advertisement content that would direct

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the user to the predetermined advertisement, selecting selected content, based on the user input, and causing the user to be directed to the selected content. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Regarding claim 50, Kurtzmann discloses the method of claim 49 wherein the predetermined advertisement is one of a plurality of items of content from which the selected content is selected. [column 2, lines 57-62]

Regarding claim 51, Kurtzmann discloses software in a readable medium comprising instructions for causing a processor to perform the following operations in a processing environment in which content may be accessed: receive input from a user; monitor content in the processing environment to be accessed by the user; determine whether monitored content includes predetermined advertisement content that would direct the user to a predetermined advertisement; and the monitored content includes predetermined advertisement content that would direct the user to the predetermined advertisement, selecting selected content, based on the user input, and causing the user to be directed to the selected content. [column 1, lines 22-34; column 1, line 55-column 2, line 29; column 2, line 53-column 3, line 50; column 3, line 58-column 4, line 25]

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtzmann.

Regarding claim 16, Kurtzmann discloses the method of claim 1.

Kurtzmann does not expressly disclose wherein monitoring occurs at the user's computer system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kurtzmann to have monitoring done on a client machine. The Examiner takes Official Notice that the concept of executing operations on a client machine that are normally done on a server in order to distribute the processing burden normally placed on the server is well known and used in the art. Therefore, one of ordinary skill in the art would have applied this concept to modify Kurtzmann to achieve the invention as claimed.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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The following prior art discloses systems and methods similar to those claimed:

US Patent 6 144 944 A to Kurtzmann, II;

US Patent 6 141 010 A to Hoyle;

US Patent 6 138 142 A to Linsk;

US Patent 5 754 939 A to Herz et al;

US Patent 6 487 538 B1 to Gupta et al;

US Patent 5 959 623 A to van Hoff et al;

US Patent 5 848 396 A to Gerace;

US Patent 6 453 335 B1 to Kaufmann.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter, Jr. whose telephone number is 703-305-4565. The examiner can normally be reached on Mon-Fri 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

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July 29, 2003



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SUPERVISORY PATENT EXAMINER
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